



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,473	09/18/2000	Hugh Sharkey	17616-842	6257

23715            7590            03/28/2003

JOEL R. PETROW  
SMITH & NEPHEW, INC.  
1450 BROOKS ROAD  
MEMPHIS, TN 38116

[REDACTED] EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 03/28/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

MP

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/664 433	Shankley et al
Examiner	d. shay	Group Art Unit 3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on January 27, 2003.
- This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 57-66 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 57-66 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection set forth in the previous office action is hereby repeated.

Claims 57-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand ('709) in combination with Makower et al. Sand ('709) teaches a method such as claimed except the use of RF, use of painting strokes and use on patellar tendons per se. Makower et al teach the equivalence of RF energy and laser energy for heating tissue and deflecting the probe to reach a desired to target tissue. It would have been obvious to artisan of ordinary skill to employ RF energy in the method of Sand ('709) since this is not critical and these are equivalent for tissue heating, as taught by Makower et al, to employ the method on patellar tendons, since Sand ('709) does not discuss avoiding these structures and to employ a painting motion, since this would allow a substantial length of the tendon to be treated all at once, and to deflect the probe, as taught by Makower et al, since Sand ('709) teaches no particular technique to reach the internal tissues which are contemplated to be treated, and since this is not critical, thus producing a method such as claimed.

Applicant argues that despite Makower's teaching that laser energy and RF can both be used to treat tissue, it is not an indication that they have "an equivalent effect" The examiner is not clear as to what exactly is meant by "equivalent effect" the examiner merely noted that both of these energies are known equivalents, as taught by Makower et al. The examiner must respectfully disagree with applicants assessment that the teachings of Makower et al "in no way describes or suggests the claimed use of RF energy to achieve a controlled modification of a

geometry of tissue". The examiner acknowledges applicants admission that Makower et al states that both laser energy and RF energy can be used for ablation. The examiner respectfully notes that the ablation of tissue is, broadly, the removal thereof, and thus is per se a controlled modification of geometry. However, as discussed by Makower et al, these energy delivery devices are thermal energy systems (see page 19, lines 28-36) the tissue heating of which is controlled by a temperature detecting system (see page 10, lines 18-28 and the paragraph spanning pages 15 and 16). The systems of Makower et al and Sand both seek to heat tissue in a controlled manner, thus clearly the equivalence of laser and RF to heat tissue in the method Makower et al would suggest one having ordinary skill in the art that they are equivalent in the method of Sand.

Applicant's arguments filed January 27,2003 have been fully considered but they are not persuasive. The arguments are not convincing for the reason set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3739

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 703-308-2215.



Shay/Dl

March 20,2003

DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330